

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT J. SILVERA

Appeal No. 2004-1258
Application No. 09/268,412

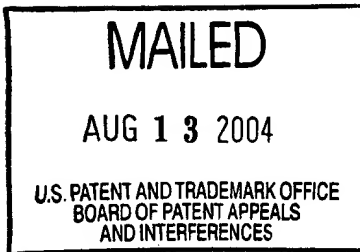
ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2,
4-9, 11-19, 21 and 22, which are all of the claims pending in this application.

We REVERSE.



BACKGROUND

The appellant's invention relates to a method of decorating a shoe (claims 1, 2, 4-9 and 21) and to a decorated shoe (claims 11-19 and 22). An understanding of the invention can be derived from a reading of exemplary claims 1 and 11, which have been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wasserman	4,697,362	Oct. 6, 1987
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Creative Crystal document dated 1997 found at <http://www.creative-crystal.com/tattoos.html> (Creative Crystal).

The admitted prior art discussed in the paragraph bridging pages 6 and 7 of the appellant's specification (Skin Wear).

Claims 1, 2, 4-9, 11, 15-19, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creative Crystal in view of Skin Wear or vice versa.¹

Claims 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creative Crystal in view of Skin Wear or vice versa, taken further in view of Wasserman.

¹The examiner has mentioned Nadel et al. U.S. Patent No. 5,577,828 and Drew U.S. Patent No. 4,120,101 in the discussion of this rejection, apparently with regard to the subject matter recited in dependent claims 4, 5, 15, 16, 21 and 22 (Answer, page 5). However, these patents were not applied as references, and therefore we have not considered them.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 26) for the examiner's reasoning in support of the rejections, and to the Brief (Paper No. 24) and Reply Brief (Paper No. 27) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention relates to decorating shoes, such as sports shoes and children's shoes, with removable stick-on tattoos. The appellant explains that in the prior art decorative designs were permanently printed or sewn onto the shoes, but that these techniques precluded the wearer from changing the designs. The appellant further acknowledges that, in an effort to overcome this disadvantage, the prior art also included securing panels having designs thereon to footwear by means of adhesives, magnetic material, and hook and loop fasteners, but urges that these methods also had disadvantages. The appellant's invention is to apply to a smooth portion of the outer surface of a shoe stick-on tattoos of film-like material which are known in the art for

application to a wearer's skin, such as those sold under the trademark Skin Wear® by Johnson & Mayer, Inc. According to the appellant, this invention solves the problems present in the prior art because they are easy to apply and are removable. See specification, pages 1, 2, 6 and 7.

The invention is set forth in the two independent claims in the following manner:

1. A method for decorating a shoe, comprising:

wetting a stick-on tattoo; and

applying the stick-on tattoo to a smooth portion of an outer surface of the shoe,

wherein the stick-on tattoo does not include separate adhesive material, and wherein the stick-on tattoo is applied to the shoe without using separate adhesive material.

11. A decorated shoe, comprising:

a shoe having an outer surface which includes a smooth portion; and

a stick-on tattoo attached to the smooth portion of the outer surface of the shoe,

wherein the stick-on tattoo does not include separate adhesive material and adheres to the shoe without use of separate adhesive material.

The examiner has rejected these claims as being obvious in view of the combined teachings of Creative Crystal and Skin Wear. In a first recitation of this rejection, the examiner finds all of the subject matter in claims 1 and 11 to be disclosed

by Creative Crystal except for the specific type of tattoo being applied to the shoe, but takes the position that it would have been obvious to one of ordinary skill in the art to utilize the type of tattoo specified in the claim because, as evidenced by Skin Wear, it was known in the art and therefore would have been "an obvious alternative artificial tattoo for decorating shoes." In the second expression of the rejection, the examiner asserts that it would have been obvious to one of ordinary skill in the art "to apply the Skin Wear tattoo to shoes as taught and suggested by Creative Crystal as an obvious alternative or added use for the Skin Wear tattoo." See Answer, pages 3 and 4. With regard to the claimed requirement that the tattoo be applied to a smooth surface of the shoe, the examiner opines that "the level of skill of attaching an artificial tattoo to a smooth surface or any surface that would accept such a tattoo is of such a low level that it would have been well within the skill of the ordinary skilled worker" (Answer, page 4), and that "a six[th] grader would have skill to find the proper surface by simple trial and error" (Answer, page 7).

The appellant disputes the findings and the conclusions reached by the examiner on the basis of lack of suggestion to combine the references in the manner proposed and lack of evidence in support thereof.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller,

642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

We shall look first at the rejection on the basis of Creative Crystal in view of Skin Wear. Creative Crystal discloses decorating tattoos "for clothing, shoes, accessories and home decor as well as skin"(page 1). While providing suggestions and instructions for use on clothing, shoes and skin, the extent of the description of the tattoos themselves is only that they are cut out with scissors, they "stick" to surfaces, and they can include rhinestones. Thus, insofar as independent claim 1 is concerned, Creative Crystal fails to disclose or teach the step of wetting a tattoo that does not include separate adhesive material and is applied to a shoe without using separate adhesive material, and the step of applying the tattoo to a smooth portion of the outer surface of the shoe. With regard to article claim 11, Creative Crystal fails to disclose or teach that

the shoe has a smooth surface, that the tattoos are attached to the smooth surface, and that the tattoos do not include a separate adhesive material and are not attached by a separate adhesive material. Interestingly, the appellant has provided another page from the Creative Crystal web site (Brief, Appendix B) which states that the tattoos are "backed with a medical adhesive specially formulated for use on human skin," which would appear to confirm that Creative Crystal tattoos are attached by an adhesive.

The Skin Wear tattoo is admitted by the appellant on page 8 of the specification to be the type used in the present invention, that is, a stick-on tattoo that "can adhere to surfaces without the need for separate adhesive." The appellant has stated on page 6 of the specification that this type of tattoo "is commonly applied to skin." The examiner has presented no evidence indicating it was known in the art to apply such a tattoo to shoes, much less to a smooth surface portion of a shoe.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to provide the Creative Crystal shoe with a smooth portion on its outer surface and to attach the tattoo disclosed in Skin Wear upon that smooth surface. We are not persuaded otherwise by the examiner's opinion that

the requisite suggestion to combine the teachings of the references in the manner proposed resides in the fact that the Skin Wear tattoo is merely an "obvious alternative" to the tattoo disclosed by Creative Crystal and the level of skill to apply an artificial tattoo to any surface that would accept such a tattoo is of a low level, in that no evidence has been adduced by the examiner to support such a conclusion. It would appear that the only suggestion for combining the teachings of the references in the manner proposed by the examiner resides in the luxury of the hindsight afforded one who first viewed the appellant's disclosure, which is not a proper basis for a rejection. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It therefore is our opinion that the teachings of Creative Crystal taken in view of those of Skin Wear fail to establish a prima facie case of obviousness with regard to the subject matter recited in claims 1 and 11. This being the case, we will not sustain this rejection of independent claims 1 and 11 or, it follows, of dependent claims 2, 4-9, 15-19, 21 and 22.

We reach the same conclusion with regard to the alternative rejection of the same claims on the basis of Skin Wear in view of Creative Crystal. The mere fact that a claimed type of tattoo was known in the prior art (Skin Wear) would not, from our perspective, in and of itself have suggested to one of ordinary skill in the art that such a tattoo be attached to a smooth portion of the outer surface of a shoe, even though it

was generally known to attach other types of tattoos to shoes (Creative Crystal). In this regard, no evidence in support of such a conclusion has been provided by the examiner, and therefore a prima facie case of obviousness is lacking.

The rejection of claims 1, 2, 4-9, 11, 15-19, 21 and 22 on the basis of Skin Wear in view of Creative Crystal is not sustained.

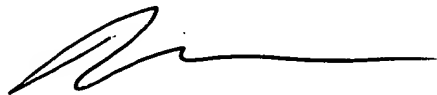
The addition of Wasserman to the above combinations of references, as applied against claims 12-14, does not cure the deficiencies present in either of the alternative rejections of claim 11, from which claims 12-14 depend. This being the case, the alternative rejections of claims 12-14 are not sustained.

CONCLUSION

None of the rejections is sustained.

The decision of the examiner is reversed.

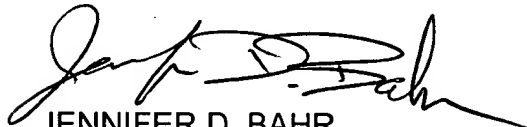
REVERSED



NEAL E. ABRAMS
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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